

B5
comedy

41. (Once Amended) The system as recited in claim 17, wherein
the at least one telephone service includes do not disturb.

REMARKS

Claims 1-42 were pending in this application. Claims 1, 2, 14-18, 30-32, 34-36, and 39-41 have been amended. No claims have been added or canceled. Hence, claims 1-42 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-34, 37-39, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the cited portions of U.S. Patent No. 6,397,040 to Titmuss, *et al.* (hereinafter "Titmuss").

Claims 35, 36, 40, and 41, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Titmuss in view of the cited portions of U.S. Patent No. 6,212,377 to Dufour, *et al.* (hereinafter "Dufour").

Claims 1, 2, 14-18, 30-32, 34-36, and 39-41 have been amended to more particularly recite the Applicant's claimed invention.

Claim Rejections Under 35 U.S.C. § 102(e)

With respect to independent claims 1 and 17, as amended, Titmuss does not teach or suggest receiving rules relating to telephone services. Titmuss teaches rules relating to information sources, not telephone services. Further, Titmuss does not teach or suggest processing a telephone call based on the user-defined, location-dependent rules and the current location of the mobile subscriber. Titmuss teaches downloading information from information sources to a terminal associated with the user. This is different from processing a telephone call. Thus, claims 1 and 17 are believed to be allowable.

Claims 2-16 and claims 33-37 depend from claim 1, and are, therefore, believed to be allowable. Likewise, claims 18-32 and claims 38-42 depend from claim

17 and are, therefore, believed to be allowable. Further, a number of these dependent claims are believed to be allowable for additional reasons. For example, claim 4 includes the limitation “wherein the specification includes receiving a signal indicating a general geographic area dependent on the current location of the subscriber.” Claim 20 includes a similar limitation. The office action does not specifically address this limitation, and Titmuss does not teach or suggest it. At the cited locations, Titmuss appears to teach actions that take place upon tracking the user. The Applicants’ “specification” relates to defining the user-defined, location dependent rules. Therefore, claims 4 and 20 are believed to be allowable for this additional reason.

Claim 5 includes the limitation “wherein the specification defines a static geographic area independent of the current location of the subscriber.” Claim 21 includes a similar limitation. Titmuss does not teach or suggest this limitation. At the cited location, Titmuss appears to teach only geographic areas that depend on the location of the user. Thus, claims 5 and 21 are believed to be allowable for this additional reason.

Claim 6 includes the limitation “wherein the static geographic area is selected from a list of predetermined geographic areas.” Claim 22 includes a similar limitation. The office action does not specifically address this limitation, and Titmuss does not teach or suggest it. At the cited location, Titmuss teaches nothing about a list of predetermined geographic areas. Thus, claims 6 and 22 are believed to be allowable for this additional reason.

Claim 7 includes the limitation “wherein the static geographic area includes a general geographic area dependent upon a known geographic location.” Claim 23 includes a similar limitation. The office action does not specifically address this limitation, and Titmuss does not teach or suggest it. Thus, claims 7 and 23 are believed to be allowable for this additional reason.

Claim 9 includes the limitation “wherein receiving the signal includes continuously receiving the signal from the wireless subscriber.” Claim 25 includes a similar limitation. Titmuss does not teach or suggest this limitation. At the cited location, Titmuss teaches various ways for tracking users, none of which specify

continuously receiving a signal. Thus, claims 9 and 25 are believed to be allowable for this additional reason.

Claim 10 includes the limitation “wherein receiving the signal includes receiving the signal from the wireless subscriber in response to a prompt from the wireless network.” Claim 26 includes a similar limitation. Titmuss does not teach anything remotely similar to this limitation at the cited locations. Thus, claims 10 and 26 are believed to be allowable for this additional reason.

Claim 12 includes the limitation “wherein receiving the signal includes receiving a strength of the signal from the mobile subscriber.” Claim 28 includes a similar limitation. The office action does not specifically address this limitation and Titmuss does not teach or suggest anything about a strength of the signal. Thus, claims 12 and 28 are believed to be allowable for this additional reason.

Claim 13 includes the limitation “wherein receiving the signal includes receiving signal propagation timing information from the mobile subscriber.” Claim 29 includes a similar limitation. The office action does not specifically address the limitation and Titmuss does not teach anything about signal propagation timing information. Thus, claims 13 and 29 are believed to be allowable for this additional reason.

Claim 14 includes the limitation “receiving an outgoing call from the mobile subscriber; and processing the outgoing call based on the user-defined, location-dependent rules and the current location of the subscriber.” Claim 30 includes a similar limitation. The office action does not specifically address this limitation and Titmuss does not teach or suggest outgoing calls. Titmuss deals exclusively with information directed toward the user. Thus, claims 14 and 30 are believed to be allowable for this additional reason.

Claim 15 includes the limitation “receiving an incoming call for receipt by the mobile subscriber; and processing the incoming call based on the user-defined, location-dependent rules and the current location of the subscriber.” Claim 31 includes a similar limitation. The office action does not specifically address this limitation and

Titmuss does not teach or suggest it. Thus, claims 15 and 31 are believed to be allowable for this additional reason.

Claim 34 includes the limitation “wherein the at least one telephone service includes caller identification.” Claim 39 includes a similar limitation. Titmuss does not teach or suggest this limitation. At the location cited by the examiner, Titmuss appears to teach a data field that stores the identity of a terminal being used by a user, which has nothing to do with caller identification services. Thus, claims 34 and 39 are believed to be allowable for this additional reason.

Claim Rejections Under 35 U.S.C. 103(a)

With respect to the rejections of claims 35, 36, 40, and 31, under 35 U.S.C. §103(a), the Applicants cannot locate the motivation to combine Dufour with Titmuss in the sections of Dufour cited in the office action. The office action states that the motivation is “to provide basic services for wireless phones.” Titmuss appears to teach the delivery of information to users from information sources. Dufour appears to teach basic telephone services. Neither teach a motivation to provide user-defined, location dependent telephone services, such as call-forwarding and do-not-disturb, to a mobile subscriber associated with a wireless network. Thus, the Applicants believe the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria.

Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly

or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added) Because no reference is cited that provides the teaching, suggestion, or motivation to modify Titmuss in light of Dufour, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03. Claims 35, 36, 40, and 31, are, therefore, believed to be allowable for this additional reason.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Donald E. Gillespie, et al.
Application No.: 09/444,359
Page 10

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Irvin E. Branch', written over a horizontal line.

Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:al
DE 7093579 v1

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Twice Amended) A method for processing ~~communication~~telephone ~~call~~services for a mobile subscriber associated with a wireless network, the method comprising:

receiving from the mobile subscriber user-defined, location-dependent rules associated with at least one telephone ~~communication~~-service subscribed to by the mobile subscriber;

determining a current location of the mobile subscriber; and

processing ~~the a telephone call~~ communication-services based on the user-defined, location-dependent rules and the current location of the mobile subscriber.

2. (Twice Amended) The method as recited in claim 1 wherein receiving the user-defined, location-dependent rules comprises:

receiving from the subscriber a specification for at least one geographic area associated with the mobile subscriber; and

receiving from the subscriber rules for processing the at least one telephone ~~communication~~-service for the mobile subscriber when the mobile subscriber is in one of the geographic areas.

3. (Previously Once Amended) The method as recited in claim 2 wherein the specification defines a dynamic geographic area dependent on the instantaneous location of the subscriber.

4. (Previously Once Amended) The method as recited in claim 2 wherein the specification includes receiving a signal indicating a general geographic area dependent on the current location of the subscriber.

5. (Previously Once Amended) The method as recited in claim 2 wherein the specification defines a static geographic area independent of the current location of the subscriber.

6. (Previously Once Amended) The method as recited in claim 5 wherein the static geographic area is selected from a list of predetermined geographic areas.

7. (Previously Once Amended) The method as recited in claim 5 wherein the static geographic area includes a general geographic area dependent upon a known geographic location.

8. (As Filed) The method as recited in claim 1 wherein the wireless network includes at least one base station at a known location for communicating with the mobile subscriber and wherein determining the current location of the mobile subscriber comprises:

receiving a signal from the mobile subscriber; and
determining the location of the mobile subscriber based on the signal from the mobile subscriber and the known location of the at least one base station.

9. (As Filed) The method as recited in claim 8 wherein receiving the signal includes continuously receiving the signal from the wireless subscriber.

10. (As Filed) The method as recited in claim 8 wherein receiving the signal includes receiving the signal from the wireless subscriber in response to a prompt from the wireless network.

11. (As Filed) The method as recited in claim 8 wherein receiving the signal includes receiving a Global Positioning Signal from the mobile subscriber.

12. (As Filed) The method as recited in claim 8 wherein receiving the signal includes receiving a strength of the signal from the mobile subscriber.

13. (As Filed) The method as recited in claim 8 wherein receiving the signal includes receiving signal propagation timing information from the mobile subscriber.

14. (Twice Amended) The method as recited in claim 1 wherein processing the a telephone call communication services comprises:
receiving an outgoing call from the mobile subscriber; and
processing the outgoing call based on the user-defined, location-dependent rules and the current location of the subscriber.

15. (Twice Amended) The method as recited in claim 1 wherein processing the a telephone call communication services comprises:
receiving an incoming call for receipt by the mobile subscriber; and
processing the incoming call based on the user-defined, location-dependent rules and the current location of the subscriber.

16. (Twice Amended) The method as recited in claim 1 further comprising:
determining supplemental subscriber information from the mobile subscriber; and
wherein processing the a telephone call communication services further comprises processing the telephone call communication services based on the supplemental subscriber information, the current location of the subscriber and the user-defined, location-dependent rules.

17. (Twice Amended) A system for processing telephone communication services for a mobile subscriber associated with a wireless network, the system comprising:

a database for storing user-defined, location-dependent rules associated with at least one telephone communication-service subscribed to by the mobile subscriber; and

service logic for determining a current location of the mobile subscriber and generating call processing instructions for processing the telephone calls communication services-based on the user-defined, location-dependent rules and the current location of the mobile subscriber.

18. (Twice Amended) The system as recited in claim 17 further comprising an interface operable to receive from the mobile subscriber a specification for at least one geographic area associated with the mobile subscriber and rules for processing the telephone communication-services for the mobile subscriber when the mobile subscriber is in one of the geographic areas.

19. (Previously Once Amended) The system as recited in claim 18 wherein the specification includes a dynamic geographic area dependent on the instantaneous location of the subscriber.

20. (Previously Once Amended) The system as recited in claim 19 wherein the interface is further operative to receive a signal as part of the specification that defines a changing geographic area dependent on the current location of the subscriber.

21. (Previously Once Amended) The system as recited in claim 18 wherein the specification includes at least one static geographic area independent of the current location of the subscriber.

22. (Previously Once Amended) The system as recited in claim 21 wherein the static geographic area is selected from a list of predetermined geographic areas.

23. (Previously Once Amended) The system as recited in claim 21 wherein the static geographic area includes a general geographic area dependent upon a known geographic location.

24. (Previously Once Amended) The system as recited in claim 17 wherein the wireless network includes at least one base station at a known location for communicating with the mobile subscriber and wherein the service logic, in determining the current location of the mobile subscriber, is further operative to receive a signal from the mobile subscriber, and determine the location of the mobile subscriber based on the signal from the mobile subscriber and the known location of the at least one base station.

25. (As Filed) The system as recited in claim 24 wherein the service logic, in receiving the signal, is further operative to continuously receive the signal from the mobile subscriber.

26. (As Filed) The system as recited in claim 24 wherein the service logic, in receiving the signal, is further operative to receive the signal from the mobile subscriber in response to a prompt by the service logic.

27. (As Filed) The system as recited in claim 24 wherein the service logic, in receiving the signal, is further operative to receive a Global Positioning Signal from the mobile subscriber.

28. (As Filed) The system as recited in claim 24 wherein the service logic, in receiving the signal, is further operative to receive a strength of the signal from the mobile subscriber.

29. (As Filed) The system as recited in claim 24 wherein the service logic, in receiving the signal, is further operative to receive signal propagation timing information from the mobile subscriber.

30. (Twice Amended) The system as recited in claim 17 wherein the service logic, in processing ~~the telephone calls~~ communication services, is further operative to receive an outgoing call from the mobile subscriber, and process the outgoing call based on the user-defined, location-dependent rules and the current location of the subscriber.

31. (Twice Amended) The system as recited in claim 17 wherein the service logic, in processing ~~the telephone calls~~ communication services, is further operative to receive an incoming call for receipt by the mobile subscriber, and process the incoming call based on the user-defined, location-dependent rules and the current location of the subscriber.

32. (Twice Amended) The system as recited in claim 17 wherein the service logic is further operative to determine supplemental subscriber information from the mobile subscriber and process ~~the telephone calls~~ communication services based on the supplemental subscriber information, the current location of the subscriber and the user-defined, location-dependent rules.

33. (As Filed) The method as recited in claim 1, wherein the current location of the mobile subscriber includes an area not defined by the boundaries of a cell of the wireless network.

34. (Once Amended) The method as recited in claim 1, wherein the at least one telephone ~~communication~~-service includes caller identification.

35. (Once Amended) The method as recited in claim 1, wherein the at least one telephone ~~communication~~-service includes call forwarding.

36. (Once Amended) The method as recited in claim 1, wherein the at least one telephone ~~communication~~-service includes do not disturb.

37. (As Filed) The method as recited in claim 2, wherein at least one geographic area is not defined by the boundaries of a cell of the wireless network.

38. (As Filed) The system as recited in claim 17, wherein the current location of the mobile subscriber includes an area not defined by the boundaries of a cell of the wireless network.

39. (Once Amended) The system as recited in claim 17, wherein the at least one telephone ~~communication~~-service includes caller identification.

40. (Once Amended) The system as recited in claim 17, wherein the at least one telephone ~~communication~~-service includes call forwarding.

41. (Once Amended) The system as recited in claim 17, wherein the at least one telephone ~~communication~~-service includes do not disturb.

42. (As Filed) The system as recited in claim 18, wherein at least one geographic area is not defined by the boundaries of a cell of the wireless network